

## REMARKS

### A. Supplemental Information Disclosure Statement

On March 13, 2003, Applicant filed a Supplemental Information Disclosure Statement in accordance with 37 C.F.R. § 1.97(c). Applicant requested in his Amendment of April 30, 2003 that the Supplemental Information Disclosure Statement be considered and the art cited therein reviewed and made of record in the next Office Action. The present Office Action has not indicated that the Supplemental Information Disclosure Statement has been received or considered. Accordingly, once again Applicant requests that the Supplemental Information Disclosure Statement be considered and made of record in the next Office Action.

### B. 35 U.S.C. § 103

Claims 1-12 were rejected under 35 U.S.C. § 103 as being obvious in view of Admitted Prior Art and DE 299 11 508 U1 (“the ‘508 reference”). The Office Action concedes that the Admitted Prior Art does not disclose having a coupling with first and second stops as recited in the claims. The Office Action asserts that it would have been obvious to use the coupling of the ‘508 reference in the Admitted Prior Art device. Applicant traverses this rejection for several reasons. First, the Office Action fails to particularly point out what elements are being relied on as the recited first and second stops. This is unfair to the Applicant since it leaves it to him to guess the basis for the rejection. Accordingly, Applicant requests a more detailed explanation of the rejection be made in the next Office Action should the rejection be repeated.

The rejection is improper for the additional reason that the ‘508 reference fails to disclose a coupling with first and second stops that “limit said radial and axial compensating movements”

as recited in claim 1. As shown in FIG. 4 of the '508 reference, the screws 8 are screwed into projecting strips (not labeled) positioned directly behind the flanges 4 and 6. The stator 9.2 is able to move in a single radial direction, to the right or left shown in FIG. 4, until one of the projecting strips contacts the stator 9.2. However, there is no stop that limits movement of the coupling in an axial direction (perpendicular to the page shown in FIG. 4). Since the '508 reference does not disclose or suggest a stop that limits movement in an axial direction, the rejection is improper.

An embodiment of the claimed first and second stops and how radial and axial compensating movement is limited is shown by the embodiment shown in FIG. 2 of Applicant's specification. In this case, the screws 4 are first inserted into holes 3.2 of brackets 3.1 and into strips 1.2. The inner ends of the screws 4 are also inserted into elongated holes 2.1 formed in the stator 2. Thus, radial movement along direction Y (within plane containing FIG. 2) is limited when the strips 1.2 contact the stator 2. Axial movement (perpendicular to the plane containing FIG. 2) is limited to when the inner ends of the screws 8 contact the edge forming the holes 2. As discussed below in Section D, the embodiment of FIG. 2 is also able to limit radial compensating movement along the X direction as well. In this example, the interaction between the screws 8 and the edges that form the elongated holes 2 defines the limited axial motion.

In summary, the '508 reference does not disclose or suggest limiting axial corrective movement as recited in claim 1. Without such suggestion, the rejection is improper and should be withdrawn.

**C. New Claims 13 and 16**

New claims 13 and 16 depend directly or indirectly on claim 1 and so are patentable for at least the same reasons given above in Section B. The claims are patentable for the additional reason that they each recite that the axial compensating movement is performed in a direction parallel to the axis of rotation of the rotor. As explained above in Section B, the ‘508 reference only discloses limiting movement in a plane that is perpendicular to the axis of rotation of its rotor. Since there is no suggestion to alter the structure of the ‘508 reference to allow for limiting movement in a direction parallel to the axis of rotation, claims 13 and 16 are patentable over the ‘508 reference and should be allowed.

Please note that new claims 13 and 16 are being presented to provide additional coverage for an angle measuring system and so are not being presented for reasons of patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722, 122 S. Ct. 1831 (2002).

**D. New Claims 14 and 17**

New claims 14 and 17 depend directly or indirectly on claim 1 and so are patentable for at least the same reasons given above in Section B. The claims are patentable for the additional reason that they each recite that the radial compensating movement is performed in two radial directions that are perpendicular to one another. As explained above in Section B, the ‘508 reference only discloses limiting movement in a single radial direction in a plane. Since there is no suggestion to alter the structure of the ‘508 reference to allow for limiting movement in two

radial directions that are perpendicular to one another, claims 14 and 17 are patentable over the ‘508 reference and should be allowed.

Note that in Applicant’s embodiment shown in FIG. 2, radial movement along the X direction is limited by the interaction of the screws 4 with the side edges that form the opening 2.1. Couple this with the discussion above in Section B, then it is apparent that the embodiment of FIG. 2 allows for compensation along the X and Y directions.

Please note that new claims 14 and 17 are being presented to provide additional coverage for an angle measuring system and so are not being presented for reasons of patentability as defined in *Festo*.

**E. New Claims 15 and 18**

New claims 15 and 18 depend directly on claims 13 and 16, respectively, and so are patentable for at least the same reasons given above in Section C. The claims are patentable for the additional reason that they each recite that the radial compensating movement is performed in two radial directions that are perpendicular to one another and perpendicular to the axis of rotation. As explained above in Section B, the ‘508 reference only discloses limiting movement in a single radial direction in a plane. Since there is no suggestion to alter the structure of the ‘508 reference to allow for limiting movement in two radial directions that are perpendicular to one another and perpendicular to the axis of rotation, claims 15 and 18 are patentable over the ‘508 reference and should be allowed.

Please note that new claims 15 and 18 are being presented to provide additional coverage for an angle measuring system and so are not being presented for reasons of patentability as

defined in *Festo*.

### **CONCLUSION**

In view of the arguments above, Applicant respectfully submits that all of the pending claims 1-18 are in condition for allowance and seek an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, she is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,



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